

REMARKS/ARGUMENTS

Claims 1-28 were pending in the application of which claims 1, 15, 20, and 24 were independent claims. Claims 1, 3, 11, 15, 17, 20, 22, 24, and 27 have been amended above. The amended claims are fully supported by the specification and add no new subject matter. No claims have been cancelled or added. Accordingly, claims 1-28 are still pending of which claims 1, 15, 20, and 24 are independent claims.

Amendments to the Claims:

Applicant has corrected a few minor typos in the claims through the above amendments to claims 3, 17, 22, and 27. Specifically, the word “leas” was corrected to “less”. Applicant believes that the amendments do not add new matter and are fully supported by the original specification.

Applicant has also amended claims 1, 15, 20, and 24 by adding an additional limitation. This limitation was previously presented in claim 11, and is also supported by Figure 2 of the specification. Applicant believes that the amendments do not add new matter and are fully supported by the original specification.

Claim Rejections Under § 112:

Paragraph 3 of the Action rejects claims 1, 15, 20, and 24 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Specifically, the Action states that there is insufficient antecedent basis for “the location of items”. Applicant disagrees.

MPEP 2173.05(e) states "for example, the limitation 'the outer surface of said sphere' would not require an antecedent recitation that the sphere has an outer surface. See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter").

The preamble in question states "RFID tags for tracking the location of items". There can be no dispute that *a location* of an item is an inherent characteristic. Thus, "*the location*" does not require antecedent recitation that an item has a location.

For at least the above reasons, Applicant believes that the original pending claims were sufficiently definite. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1, 15, 20, and 24.

Claim Rejections Under § 103:

Paragraph 5 of the Office Action rejects claims 1-28 under 35 U.S.C. § 103(a) as allegedly being obvious over Horwitz (U.S. 6,496,806) in view of Francis (U.S. 6,600,418). With respect to claims 1-28, Applicant respectfully traverses the rejection because Horwitz in view of Francis fails to make out a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to allege a claim is obvious when references are combined under 35 U.S.C. 103(a) the combination must teach each and every limitation of the claim. In this case, the rejection must fail because Horwitz and Francis alone or in combination, fail to teach each and every element of the claims as amended.

Further, as the Federal Circuit has made clear, the first two criteria inform the prongs of the three-way test referred to in *Graham v. John Deere* in order to prevent the reliance on impermissible hindsight. In this case, the references fail to provide a proper motivation to combine the references or reasonable expectation of success. Accordingly, with respect to claims 1-28 the rejection must fail and is at best based on improper hindsight.

For example, certain embodiments of the present application are directed to a method for configuring a controlled area with RFID tags for tracking the location of items within the controlled area. More specifically, claim 1 is directed at "a method for configuring a controlled area with RFID tags for tracking the location of items within the controlled area, the method comprising: determining a measurement accuracy for the location of the items; determining locations for a plurality of RFID tags based on the determined measurement accuracy; placing the plurality of RFID tags in accordance with the determined locations; placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the

plurality of RFID tags and separated by a separation distance for determining the location of the items.”

The Action admits that Horwitz fails to teach “placing two RFID interrogators on a vehicle used to move items within the controlled area.” Applicant notes that the limitation of claim 1 (as amended) reads “placing two RFID interrogators on a vehicle used to move items within the controlled area, the RFID interrogators each configured to read the plurality of RFID tags and separated by a separation distance for determining the location of the items.” With regard to the limitation previously found in claim 11, the Action cites to Francis (see Action, ¶ 5(K), referring to Francis, Col. 8, lines 19-27) as teaching this limitation. Applicant disagrees the Horwitz or Francis, either alone or in combination, teach this limitation.

The section cited by the Action (Col. 8 lines 19-27) of Francis, in full, states:

“The transport vehicle 110 may also be equipped to interrogate RFID tags located at a number of different locations (such as heights) relative to the vehicle 110 and/or tags communicating at *different frequencies* (for example, *tags for inventory items may use a different frequency than those for locations*). This versatility may be achieved by connecting multiple antennas, *each having a different orientation*, to an interrogator, or mounting multiple RFID interrogators, *each with its own frequency*, on the same vehicle.”

Francis only teaches using the interrogators for different purposes e.g. extending the range of the interrogators via multiple antennas or for identification of an item (e.g. different frequencies, different heights, or different directions) and is completely silent as

to separating the interrogators by a separation distance for determining the location of the items. In Francis, the relative distance between the interrogators is irrelevant, as Francis does not teach using multiple interrogators in combination to read the RFID tags in order to determine an item's location. As an example, in column 9 under the heading "Motion and Direction determination" (line 25), Francis specifically states that motion and direction are determined by using two RFID tags and *one* interrogator. However, Francis is completely silent as to using two interrogators and a *single* RFID tag to track the item (e.g. the direction, speed, etc.) as taught and claimed in the present application. Thus, Francis cannot make up for the deficiencies of Horwitz.

Claim 15, 20, and 24 have been amended similar to claim 1 and are therefore allowable for at least the same reasons as discussed above with regard to claim 1.

Accordingly, Horwitz in view of Francis cannot anticipate claim 1, 15, 20, or 24. Claims 2-14 depend upon claim 1, and are therefore allowable for at least the same reasons as claim 1. Claims 16-19 depend upon claim 15, and are therefore allowable for at least the same reasons as claim 15. Claims 21-23 depend upon claim 20, and are therefore allowable for at least the same reasons as claim 20. Claims 25-28 depend upon claim 24, and are therefore allowable for at least the same reasons as claim 24. Applicant, therefore respectfully requests withdrawal of the rejection of claims 1-28.

CONCLUSION

Based on the above amendments and remarks, Applicant believes that the claims are in condition for allowance and such is respectfully requested. Applicant believes that no additional fees are necessitated by this response. The Commissioner is hereby authorized to charge any additional fees required by this response to our Deposit Account No. **13-0480** (Attorney Docket No. 67176389.001400).

Respectfully Submitted,

By: /Noel C. Gillespie/

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Noel C. Gillespie, Reg. No. 47,596
Baker & McKenzie LLP
2001 Ross Avenue, Suite 2300
Dallas, TX 75201
Telephone: (858) 523-6231
Facsimile (214) 978-3099